

REMARKS

Claims 1-27 are pending in this application. Claims 1-27 have been rejected. In view of foregoing amendments and following remarks, the Applicants respectfully request allowance of the Application.

Claim Rejections under 35 U.S.C. §103(a)

Claims 1-10, 13-18, 20 and 22-27 were rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent Application Publication No. 2002/0072999 ("Corrie"), in view of U.S. Patent Application Publication No. 2005/0192826 ("Kanefsky"). Claims 11, 19 and 21 were rejected under 35 U.S.C. § 103(a) as unpatentable over Corrie and Kanefsky in view of Official Notice. Claim 12 was rejected under 35 U.S.C. § 103(a) as unpatentable over Corrie and Kanefsky, and in further view of U.S. Patent No. 7,111,010 to Chen et al. ("Chen").

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). As clearly indicated by the Supreme Court, it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As explained herein, the Office Action does not satisfy these requirements as to all of the features of the claims.

Kanefsky Is Not a Proper Prior Reference

The present application has a filing date of September 30, 2003. Kanefsky on its face has a filing date of August 20, 2004 and claims priority from a Provisional Application No. 60/496,826 ("Kanefsky Provisional") filed on August 21, 2003. Since the filing date of the present application is prior to that of Kanefsky, Kanefsky by its filing date alone is not a prior reference to the present application. To the extent that the Examiner relied on the filing date of Kanefsky Provisional, the Examiner has the burden to establish that Kanefsky Provisional discloses the same subject matter as Kanefsky at least for the portions of Kanefsky relied on by the Examiner.

Kanefsky Provisional does not disclose the subject matter of Kanefsky on which the Examiner relied. This is best illustrated by examples. The Examiner relied on Fig. 1 and corresponding text of para. 0021 of Kanefsky as assertedly disclosing features recited in claim 1. However, any reading of Kanefsky Provisional does not contain a corresponding Fig. 1 or describe a system as illustrated in Fig. 1. Further, the Examiner also relied on para. 0033 of Kanefsky as assertedly disclosing features recited in claim 1. The para. 0033 of Kanefsky concerns with and describes corresponding Fig. 4 of Kanefsky. However, any reading of Kanefsky Provisional does not contain a corresponding Fig. 4 or describe a system as illustrated in Fig. 4. Accordingly, Kanefsky Provisional does not disclose the subject matter cited by the Examiner and therefore, Kanefsky is not a proper prior reference to the present application since Kanefsky's filing date is after that of the present application.

Even if Kanefsky were a prior reference to the present application (which is not conceded by any means), the combination of Corrie and Kanefsky still does not render claims 1-27 unpatentable.

Claims 1-5 Define Over the Combination of Corrie and Kanefsky

Independent claim 1 states in part:

A computer-implemented grants management method for managing a plurality of grants for a recipient received from a plurality of grant sponsors, comprising:

responsive to a transaction request and data associated therewith, converting values of the associated data from a domain of a

transaction system to a domain defined for one of the plurality of grants,

determining if the converted data maps to a classification that has been defined under the one of the plurality of grants to be valid.

The Examiner expressly admitted that Corrie does not disclose the above quoted features. Instead, the Examiner relied on Kanefsky as assertedly disclosing these features.

Kanefsky does not disclose the above quoted features. In particular, Kanefsky at least does not disclose the feature of **"responsive to a transaction request and data associated therewith, converting values of the associated data from a domain of a transaction system to a domain defined for one of the plurality of grants."** In fact, the Examiner in the Final Office Action failed to allege any part of Kanefsky as disclosing the highlighted feature (see Final Office Action p.3). Therefore, the combination of Corrie and Kanefsky does not disclose all the features of claim 1 and its dependent claims 2-5.

Accordingly, claim 1 and its dependent claims 2-5 are allowable for the reasons set forth above.

Claims 6-10, 26 and 27 Define Over the Combination of Corrie and Kanefsky

Independent claims 6, 10, 26 and 27 include similar features as claim 1 and therefore, are allowable for the same reasons as claim 1. Claims 7-9 include all features of claim 6 since they ultimately depend from claim 6 and therefore are allowable for at least the same reasons as claim 6.

Claims 13-18, 20, 22-25 Define Over Corrie

Independent claim 13 states in part:

a computer-implemented_method for managing a plurality of grants for a recipient received from a plurality of grant sponsors.

The Examiner expressly admitted that Corrie does not disclose the above quoted feature. Instead, the Examiner relied on Kanefsky as assertedly disclosing the feature.

Kanefsky does not disclose the above quoted feature. Kanefsky merely concerns with a system or method for a grantor where multiple grantees may report expenses. In contrast, claim 13 provides a method for a **single** grantee (recipient) to manage a plurality of grants

from a plurality of grantors (sponsors). Therefore, Kanefsky does not disclose the above quoted feature.

Accordingly, claim 13 and its dependent claims 14-18 are allowable for the reasons as set forth above.

Independent claims 20 and 23, and their respective dependent claims 24-25 include similar features as claim 13 and therefore, are allowable for the same reasons as claim 13.

Claims 11, 19 and 21 Define Over Corrie and Kanefsky and Official Notice

Claims 11, 19 and 21 include all features of independent claims 10, 13 and 20 since claims 11, 19 and 21 ultimately depend from claims 10, 13 and 20, respectively and therefore, are allowable for at least the same reasons as claims 10, 13 and 20 since the Official Notice does not cure the critical deficiencies of Corrie and Kanefsky.

Claim 12 Defines Over Corrie, Kanefsky and Chen

Claim 12 includes all features of independent claim 10 since claims 12 ultimately depends from claims 10 and therefore, is allowable for at least the same reasons as claims 10 since the tertiary Chen reference does not cure or allegedly cure the critical deficiencies of Corrie and Kanefsky.

Applicant: Kobeh Gerardo et al.
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CONCLUSION

All outstanding rejections have been overcome. It is respectfully submitted that, in view of the foregoing amendments and remarks, the application is in clear condition for allowance. Issuance of a Notice of Allowance is earnestly solicited.

Although not believed necessary, the Office is hereby authorized to charge any fees required under 37 C.F.R. § 1.16 or § 1.17 or credit any overpayments to Deposit Account No. 11-0600.

The Office is invited to contact the undersigned at 202-220-4200 to discuss any matter regarding this application.

Respectfully submitted,

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